

Serial No. 09/986,919

**REMARKS**

In accordance with the foregoing, claims 3 and 4 have been amended and claims 13-43 have been cancelled without prejudice or disclaimer. No new matter has been entered. Therefore, claims 1-12 and 44 are pending and reconsideration is respectfully requested.

**CLAIM OBJECTIONS:**

Claims 3 and 4 are objected to under 37 CFR §1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. However, since claims 3 and 4 have been amended to recite terms in agreement with the language of claim 1. Thus, it is respectfully requested that the objections be withdrawn.

**REJECTIONS UNDER 35 U.S.C. §112:**

Claims 1-12 and 44 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement because the recitation of the range, "at or greater than 60% porosity and less than 90% porosity," was not part of the original disclosure. However, as applicant has noted in previous Office Actions, original claims 3 and 4, which are to be understood as being supported by the original disclosure according to section 2163(l)(A) of the MPEP, together define a range of "at or greater than 60%" and "less than 90%," respectively. Thus, it is requested that the Examiner either withdraw this rejection or present some reference or argument as to why the subject matter of original claims 3 and 4 does not support the presently claimed range.

For example, if it is the Examiner's position that either an aspect of the originally claimed invention was not described with sufficient particularity such that one skilled in the art would recognize that the applicant had possession of the claimed invention, then applicants respectfully request that the Examiner make clear what aspect of the originally claimed invention was not described with sufficient particularity. Similarly, if it is the Examiner's position that the original claims 3 and 4 require an essential or critical feature which was not adequately described in the specification and which was not conventional in the art or known to one of ordinary skill in the art, then applicants respectfully request that the Examiner explain what critical feature was not adequately described. Failing that, applicants submit that the rejection should be withdrawn.

Serial No. 09/986,919

As a pre-emptive matter, if it is the Examiner's position that the ranges disclosed by the claims 3 and 4 are not adequately described in the specification as originally filed because paragraph [0015] of the original specification does not mention these specific ranges, applicants note that it would not require any degree of expertise to substitute the specified claim ranges with the claimed ranges of claims 3 and 4. As such, any dissimilarity between the specification and the claims does not rise to the level of the examples provided by the section 2163(I)(A). Therefore, such dissimilarities do not justify a "written description" rejection.

**REJECTIONS UNDER 35 U.S.C. §103:**

Claims 1-5 and 9-12 are rejected under 35 U.S.C. §103(a) as being unpatentable over Chu et al. (U.S. Patent 6,030,720) in view of Peled et al. (U.S. Patent 4,410,609), and claims 6-8 and 44 are rejected under 35 U.S.C. §103(a) as being unpatentable over Chu et al. (U.S. Patent 5,686,201) in view of Peled et al. (U.S. Patent 4,410,609) as applied to claims 1 and 5 above, and further in view of Kawakami (U.S. Patent 6,475,664).

Regarding the rejections of claims 1-5 and 9-12, applicants note that the Examiner suggests that since Chu does not disclose that the disclosed current collector comprises at least 60% porosity and less than 90% porosity based on an overall volume of the current collector, it would have been obvious to combine the Peled teaching of a positive current collector having 80% or 75-90% porosity with the teachings of Chu. In support of this position, the Examiner states that having the porosity of the current collector in Chu to be 80% porous "would provide a cathode with high porosity so as to allow extensive electrolyte solvent communication throughout the bulk of the cathode and improve ionic conductivity in the electrode and lead to improved battery performance." Applicants disagree with this analysis for at least the following reason.

Noting that the Examiner did not cite any section of either Chu or Peled for the proposition that having the porosity of the current collector in Chu to be 80% porous "would provide a cathode with high porosity so as to allow extensive electrolyte solvent communication throughout the bulk of the cathode and improve ionic conductivity in the electrode and lead to improved battery performance," applicants respectfully submit that this reasoning is indeed not found in either of the references, but rather, was arrived at by the Examiner alone. Such analysis is prohibited under, for example, section 2143.01 of the MPEP which states that "obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves."

Serial No. 09/986,919

With respect to the suggested combination here, there is no explicit evidence in Chu, nor implicit evidence that can be gleaned from Chu that the suggested combination with Peled would produce the results predicted by the Examiner. In fact, Chu contains no teaching or suggestion that a current collector of a particular porosity would provide any benefits over and above that of any other current collector. Moreover, it follows that Chu does not disclose any indications that modifying the porosity of the current collector as suggested by the Examiner would have negative effects on the performance of the feature. Here, applicants assert that if the Examiner is going to make unsupported statements as to the supposedly positive effects of modifying the porosity of the Chu current collector, perhaps the Examiner should consider whether there would be any unintended consequences of the suggested modification of which there must be a few.

Therefore, applicants respectfully assert that claims 1-5 and 9-12 define over any and all combinations of the references and that the rejections of these claims are, thus, overcome.

Regarding the rejections of claims 6-8 and 44, it is noted that the additional reference to Kawakami does not cure the defects of the references to Chu and Peled and that, therefore, the claims define over any and all combinations of these references. Thus, these rejections are also overcome.

Serial No. 09/986,919

**CONCLUSION:**

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 503333.

Respectfully submitted,

STEIN, MCEWEN &amp; BUI, LLP

Date: 11/25/05By: 

Michael D. Stein

Registration No. 37,240

1400 Eye St., NW  
Suite 300  
Washington, D.C. 20005  
Telephone: (202) 216-9505  
Facsimile: (202) 216-9510

**CERTIFICATE OF TRANSMISSION**  
I hereby certify that this correspondence is being  
transmitted via facsimile to: Commissioner for Patents,  
P.O. Box 1450, Alexandria, VA 22313-1450

on 11/25, 2005  
STEIN, McEWEN & BUI, LLPBy: M. TagoDate: 11/25/05